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JUL 25 2007

Docket No. F-8846

Ser. No. 10/550,981

REMARKS

Claims 1-11 remain pending in this application. Claims 1-11 are rejected.

Claim 1 is objected to. Claims 1 and 7 are amended herein to clarify the invention. Claims 2-6, 8, 9, and 11 are amended herein to place them in better form. No new matter is added.

Claim 1 has been objected to because of the language of "such as dyes...". Appropriate correction has been made to claim 1 and Applicant respectfully requests that the objection to claim 1 be withdrawn.

Claim 1 has been rejected under 35 U.S.C. § 112, first paragraph as not enabled. The Office Action states that the language of "or the like" is not enabled. Appropriate correction has been made to claim 1. Applicants therefore respectfully request that the enablement rejection be withdrawn.

Claims 1, 3-7, and 9-11 have been rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 6,153,288 (Shih et al.).

Claims 1 and 7 have been amended to include a number of limitations. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."

See Verdegaal Brothers Inc. v. Union Oil Company of California, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Shih et al. fails to disclose all the limitations recited in claims 1 and 7. Accordingly, claims 1 and 7 are patentable over Shih

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et al. and notice to that effect is respectfully requested. Claims 3-6 and 9-11 are patentable at least for the reason that they depend from a patentable base claim.

See In re Royka and Martin, 180 USPQ 580, 583 (CCPA 1974).

The Office Action does not appear to specifically address the rejection of claims 4 and 5. Although the claims are listed as rejected, the reason for their rejection is not specifically identified. It is Applicant's position that the Office Action has not demonstrated the anticipation of claims 4 and 5 and respectfully requests that claims 4 and 5 be allowed.

Claims 2 and 8 have been rejected under 35 U.S.C. § 103(a) as obvious over Shih et al. in view of U.S. Patent No. 6,124,417 (Su).

The Office Action states that Shih et al. is silent with respect to the usage of acrylic monomer and vinyl acetate monomer as polymer components of the aqueous emulsion type acrylic pressure sensitive adhesive and relies on Su for this teaching. The Supreme Court has made clear that demonstrating that elements are known in the art is insufficient to establish obviousness and explained the importance of identifying a reason to combine the elements in the way the claimed new invention does. *See KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007). The Office Action states on pages 5-6 that the obviousness is predicated on Su disclosing emulsion polymers which are non-tacky when dry but become tacky when wet and which show 100% image transfer

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at room temperature. The EVA emulsion polymer disclosed in Shih et al. is disclosed as being used for coating a substrate. It is Applicant's position that the Office Action has failed to provide a reason why one of ordinary skill in the art would make the stated combination of Shih et al. and Su. There is no disclosure or suggestion in Su that the polymers taught are utilized in any composition for coating a substrate. Su specifically discloses that the polymers disclosed are utilized to make the substrate to be coated, as is clear from, *inter alia*, the abstract of Su. One of ordinary skill in the art would not look to components of a substrate to try to find components to add to a composition that is made to be coated. Accordingly, *prima facie* obviousness is absent and Applicant respectfully requests that claims 2 and 8 be allowed. Moreover, claims 2 and 8 are further patentable at least for the reason that they depend from a patentable base claim. See *In re Fine*, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988).

Claims 1 and 7 have been amended, support being found on the first paragraph of page 7 of the specification. The amendments to the other claims are merely to place the claims in better form.

Applicant respectfully requests that the Examiner acknowledge the receipt of a copy of the certified priority document from the International Bureau.

Applicant respectfully requests a three month extension of time for responding to the Office Action. Please charge the fee of \$510.00 for the

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extension of time to Deposit Account No. 10-1250. The USPTO is hereby authorized to charge any fee(s) or fee(s) deficiency or credit any excess payment to Deposit Account No. 10-1250.

In light of the foregoing, the application is now believed to be in proper form for allowance of all claims and notice to that effect is earnestly solicited.

Respectfully submitted,
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